

1 Greg Nylen [SBN 151129]
2 Kevin Abbott [SBN 281312]
3 LOBB & PLEWE, LLP
4 4160 Temescal Canyon Rd., Suite 202
Corona, CA 92883
Telephone: (951) 788-9410
Facsimile: (951) 788-0766
E: gnylen@lobbplewe.com
kabbott@lobbplewe.com
7

8 James Donoian (pro hac vice pending)
9 Aya Cieslak-Tochigi (pro hac vice pending)
10 McCarter & English, LLP
11 825 Eighth Avenue, 31st Floor
New York, NY 10019
P: 212-609-6817
12 E: jdonoian@mccarter.com
acieslaktochigi@mccarter.com
13

14 Keith Toms (pro hac vice pending)
15 Quincy Kayton (pro hac vice pending)
16 McCarter & English, LLP
265 Franklin St.
17 Boston, MA 02140
P: 617-449-6591
18 E: ktoms@mccarter.com
E: qkayton@mccarter.com
20

21 Aaron Y. Silverstein (pro hac vice pending)
Saunders & Silverstein LLP
22 14 Cedar Street, Suite 224
Amesbury, MA 01913
23 asilverstein@sandsip.com
Telephone: 978-463-9100
25

26 Attorneys for Plaintiffs, VANS, INC. and VF OUTDOOR, LLC
27

[caption continued on next page]

1 THE UNITED STATES DISTRICT COURT
2 FOR THE CENTRAL DISTRICT OF CALIFORNIA
3
4 SOUTHERN DIVISION

5
6 VANS, INC.; VF OUTDOOR, LLC,) Case No.: 8:18-cv-2258
7)
8 Plaintiffs,)
9)
10 vs.) **COMPLAINT**
11) **AND DEMAND FOR JURY TRIAL**
12 TARGET CORPORATION ;)
13 FARYLROBIN, LLC,)
14 Defendants.)
15)
16)
17)
18)
19)
20)
21)
22)
23)
24)
25)
26)
27)
28)

15
16
17 **COMPLAINT**
18
19
20
21
22
23
24
25
26
27
28

Plaintiff Vans, Inc., and VF Outdoor, LLC (collectively, “Vans”) by and through their counsel, brings this action against defendants Target Corporation (“Target”) and Farylrobin LLC (“Farylrobin”) (collectively, “Defendants”). As grounds for this complaint, Vans alleges the following:

29
30 **NATURE OF THE ACTION**
31
32
33
34
35
36
37
38

1. This is an action for trademark infringement and unfair competition arising under the trademark laws of the United States, 15 U.S.C. §§ 1051 *et seq.* and under the common law and deceptive and unfair trademark practices laws of the State of California, California Business and Professions Code §17200, related

1 to Defendants' sale of the "Camella Lace-Up Sneaker" ("Infringing Product"),
2 which intentionally and willfully copies the protectable trade dress and trademarks
3 of Vans' iconic Old Skool shoe ("Old Skool Shoe") and is likely to cause
4 confusion in the marketplace. Indeed, consumers on Target's own website refer to
5 the Infringing Product, depicted below, as "fake Vans," clearly indicating an
6 express association with, and a likelihood of confusion with, Vans' products.
7

8 **Vans' Old Skool Shoe**



9 **Defendants' Infringing Product**



10
11
12
13
14
15
16
17 2. Moreover, upon information and belief, Defendants' infringement was
18 motivated not only by the extreme popularity of Vans' Old Skool Shoe — which is
19 a top-selling lifestyle shoe among Defendants' target customers of millennial and
20 Gen-Z women — but also by a desire to misappropriate Vans' reputation and
21 cachet to lend unwarranted and instant credibility to Target's Wild Fable product
22 line upon its launch.

23 3. Vans has a long history of, and sterling reputation for, being authentic
24 and connected to pop-culture, street culture, and youth culture, which are the stated
25 goals for Target's Wild Fable line. As such, Defendants should not be permitted to
26 associate themselves with Vans' history and reputation by selling shoes that are
27 likely to cause confusion with the trade dress and trademarks of Vans' Old Skool
28 Shoe.

JURISDICTION AND VENUE

4. This Court has jurisdiction over the subject matter of this action pursuant to Section 39 of the Lanham Act, 15 U.S.C. § 1121, and 28 U.S.C. §§ 1331, 1332(a), and 1338, and has supplemental jurisdiction pursuant to 28 U.S.C. § 1337(a).

5. This Court has personal jurisdiction over defendant Target because it is engaged in substantial and regular business in the State of California and in the Central District of California, including by selling its goods through retail stores located in the Central District of California. Additionally, defendant Target's acts have caused injury to plaintiff Vans within the State of California and the Central District of California.

6. This Court has personal jurisdiction over defendant Farylrobin because it is engaged in substantial and regular business in the State of California and in the Central District of California. Additionally, defendant Farylrobin's acts have caused injury to plaintiff Vans within this District by supplying its infringing goods to defendant Target for sale in the State of California and in the Central District of California.

7. Venue is properly founded in this judicial district pursuant to 28 U.S.C. § 1331(b) and (c) because Defendants are subject to personal jurisdiction within this district and/or because a substantial part of the events giving rise to these claims occurred within this judicial district.

THE PARTIES

8. Vans, Inc. is a corporation organized and existing under the laws of the State of Delaware, having its principal place of business at 1588 South Coast Drive, Costa Mesa, California 92626.

1 9. VF Outdoor, LLC is a limited liability company organized and existing
2 under the laws of Delaware, having its principal place of business at 2701 Harbor
3 Bay Parkway, Alameda, California 94502.

4 10. Upon information and belief, defendant Target is a corporation organized
5 and existing under the laws of Minnesota, having its principal place of business at
6 1000 Nicollet Mall, Minneapolis, MN, 55403. Upon information and belief,
7 Target regularly transacts business in the United States and in the State of
8 California.

9 11. Upon information and belief, defendant Farylrobin is a limited liability
10 company organized and existing under the laws of New York, having a principal
11 place of business at 2011 Park Avenue South, Suite 1408, New York, NY, 10003-
12 1523. Upon information and belief, Farylrobin regularly transacts business in the
13 United States and in the State of California.

FACTS

Vans and Vans' Business

17 12. Founded in 1966 in Anaheim, California, by Van Doren brothers Paul
18 and Jim, along with partners Gordon Lee and Serge Delia, Vans has grown from
19 humble beginnings to become one of the most well-known and groundbreaking
20 footwear, apparel, and accessory companies in the world.

21 13. Vans' products are widely recognized and extremely popular. The
22 company has achieved recognition as ranking among the world's greatest and most
23 recognizable brands. Vans' iconic trademarks and distinctive trade dress related to
24 its classic shoe designs have been consistently used for decades and are known
25 throughout the world to indicate the source of Vans' high quality products. Over
26 the past 40 years, tens of millions of pairs of shoes with Vans' distinctive
27 trademarks and trade dress have been sold in the United States.

1 14. Vans' products have amassed significant goodwill and are continuing to
2 grow in popularity. Indeed, "Vans is the No. 3 'top trend' cited among teens"
3 (Piper Jaffray *Taking Stock With Teens Survey* – Fall 2018). The brand is also
4 recognized as the top-ranked footwear brand for upper-income females in the
5 United States (Piper Jaffray *Taking Stock With Teens Survey* – Fall 2018).

6 15. Much of Vans' success is owed to its enduring reputation for creating
7 lasting and durable footwear products without sacrificing comfort or style, and,
8 perhaps just as important, its longstanding and consistent use of its trademarks and
9 its trade dress. This consistent use of distinctive trademarks and trade dress,
10 combined with Vans' peerless reputation for lifestyle and active shoes, has been
11 instrumental in Vans' lasting popularity.

Vans' Old Skool Shoe

14 16. One of Vans' most popular shoe designs, and indeed one of the most
15 iconic shoe designs in history, is the Vans Old Skool Shoe, depicted below, which
16 was introduced in 1977. Few shoes have remained as consistently popular or are as
17 instantly recognizable as the Old Skool Shoe.



Vans Old Skool Shoe

1 17. The Old Skool Shoe design features the iconic “Side Stripe” trademark,
2 highlighted below. Originally known as the “jazz stripe,” this highly distinctive
3 design element has become the unmistakable hallmark of the Vans brand and is the
4 subject of three United States trademark registrations (see Paragraphs 27-29) (the
5 “Side Stripe Trademark”). The Side Stripe Trademark’s prominent placement and
6 often-contrasted color make Vans’ shoes immediately recognizable to consumers
7 even at far-off distances.



Vans Side Stripe Trademark

16 18. Since 1977, The Old Skool Shoe has continuously featured a
17 combination of distinctive source-identifying elements, including: (1) the Vans
18 Side Stripe Trademark, in contrasting color to the shoe upper; (2) a white
19 rubberized midsole; (3) a contrast line around the top edge of the midsole; (4) a
20 textured toe box outer around the front of the white midsole; and (5) visible
21 stitching, in contrasting color, including where the lace bracing meets the vamp;
22 which combined form strong enforceable trade dress (the “Old Skool Trade
23 Dress”).

24 19. Since its release in 1977, tens of millions of pairs of the Old Skool Shoes
25 have been sold in the United States. The Old Skool Shoe originally gained
26 notoriety as the shoe of choice for skaters and other active sports enthusiasts, and
27 in more recent years, the shoe's popularity has exploded with the general public,
28 including high-profile fashion designers, musicians, and celebrities. On account of

1 its pop culture popularity, the Old Skool Shoe has been the subject of numerous
2 examples of unsolicited media coverage and featured in publications aimed at a
3 broad selection of the public, including, among others, *Transworld Skateboarding*,
4 *Esquire*, *Complex*, *Business Insider*, *GQ*, *The Wall Street Journal* and *W*
5 *Magazine*.

6 20. The Old Skool Trade Dress is nonfunctional and distinctive, and the
7 public recognizes and understands that the Old Skool Trade Dress distinguishes
8 and identifies genuine Vans brand products.

9 21. As a result of Vans' extensive use of the Old Skool Trade Dress, Vans
10 has built up and now owns extremely valuable goodwill that the Old Skool Trade
11 Dress embodies.

12 22. The purchasing public has come to immediately and unmistakably
13 associate the Old Skool Trade Dress with Vans.

14 23. The enormous popularity of the Old Skool Shoe has resulted in high-
15 profile collaborations with notable designers and fashion houses in the realm of
16 haute couture and street fashion, including brands such as Marc Jacobs, Stüssy,
17 Pendleton, and Supreme, further broadening the appeal of the classic designs.

18 24. The Old Skool Shoe has also had a particularly rich history in the music
19 industry, as it is revered by band members in the rock and roll and punk music
20 scenes, in particular for its style and reputation. The Old Skool Shoe's cult status
21 amongst musicians in turn led to the development of Vans' band shoe program,
22 which was responsible for creating Old Skool designs dedicated to legendary
23 music groups like Slayer, Descendents, and Bad Religion, as well as Iron Maiden,
24 Slayer, Bad Brains, and Social Distortion.

25 25. Vans also has a rich tradition of associating the Old Skool Shoe and its
26 other products with its signature checkerboard design. Consumers encountering
27 such a checkerboard design, especially when associated with footwear or
28 accessories sold alongside footwear, are even more likely to associate the products

1 with Vans. Examples of Van's products featuring the checkerboard design
2 include:



The Famous Side Stripe Trademark

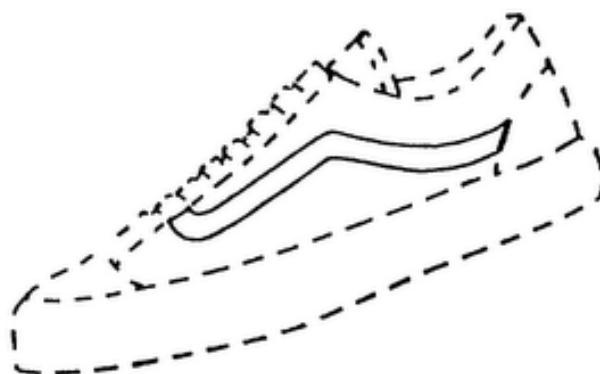
26. Since at least as early as the 1970s, Vans has used the Vans Side Stripe
27 Trademark as a distinctive design element on its footwear. Vans has expended
28 substantial time, money, and other resources in the developing, advertising, and
otherwise promoting the Side Stripe Trademark. As a result of these efforts,
consumers readily identify merchandise bearing the Side Stripe Trademark as
being high quality merchandise emanating from, sponsored by, or approved by
Vans. The Side Stripe Trademark has become well-known among consumers and

1 accordingly should be afforded tremendous strength. Examples of Vans' footwear
2 bearing the Side Stripe Trademark are depicted below.



17 *Examples of Vans' Side Stripe Trademark on Footwear*

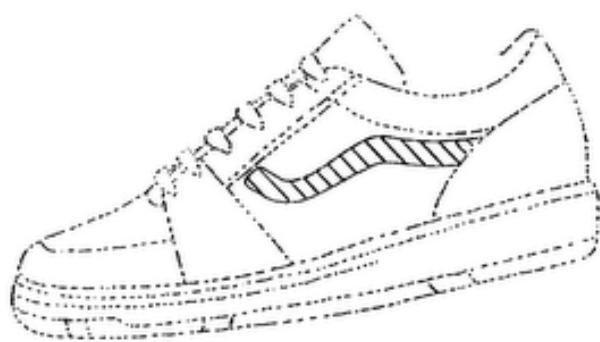
18
19 27. Vans is the owner of the Side Stripe Trademark and corresponding
20 United States Trademark Registration No. 2,177,772, issued on August 4, 1998, for
21 the placement of the Side Stripe Trademark on the Old Skool Shoe design, as
22 depicted below, for "footwear."



U.S. Registration No. 2,177,772

An Affidavit has been filed pursuant to Sections 15 of the Lanham Act, 15 U.S.C. § 1065, and this registration is contestable. A copy of the Certificate of Registration for this registration is attached as Exhibit A.

28. Vans owns United States Trademark Registration No. 2,172,482, issued on July 14, 1998, for the below-depicted shoe design incorporating the Side Stripe Trademark, for “footwear.”



U.S. Registration No. 2,172,482

An affidavit has been filed pursuant to Section 15 of the Lanham Act, 15 U.S.C. § 1065, and this registration is contestable. A copy of the Certificate of Registration for this registration is attached as Exhibit B.

29. Vans also owns United States Trademark Registration No. 2,170,961, issued July 7, 1998, for the below-depicted shoe design incorporating the Side Stripe Trademark, for “footwear.”



U.S. Trademark Registration No. 2,170,961

An affidavit has been filed pursuant to Section 15 of the Lanham Act, 15 U.S.C. § 1065, and this registration is uncontested. A copy of the Certificate of Registration for this registration is attached as Exhibit C.

30. Vans has further strengthened the Side Stripe Trademark by incorporating the mark in many designs across its entire product range. Notably, Vans prominently features the Vans Side Stripe Trademark in connection with apparel products. Vans has expended substantial time, money, and other resources in developing, advertising, and otherwise promoting the Side Stripe Trademark. As a result of these efforts, consumers readily identify merchandise bearing the Side Stripe Trademark as being of high quality and emanating from, sponsored by, or approved by Vans. Examples of Vans' apparel products bearing the Side Stripe Trademark are depicted below.





Examples of Vans' Side Stripe Trademark on Apparel Products

31. Vans is the owner of the Side Stripe Trademark and corresponding United States Trademark Registration No. 4,442,122, issued on December 13, 2013 for "clothing, namely, T-shirts, shirts, sweatshirts, pants, shorts, denims, sweater, jackets, belts, boxers, socks, scarves, underwear and swimwear; headgear, namely, hats, caps and beanies."



U.S. Registration No. 4,442,122

25 A copy of the Certificate of Registration for this registration is attached as
26 Exhibit D.

27 32. As a result of Vans' extensive use of the Side Stripe Trademark, Vans
28 has built up and now owns extremely valuable goodwill embodied in the mark.

33. The Side Stripe Trademark is a strong source identifier that has is uniquely associated with Vans and genuine Vans brand products.

Defendants' Infringing Product

34. Upon information and belief, in August 2018, in an effort to “really amp up” its style credentials with young female consumers, Target launched its Wild Fable line as a “way to be more authentic and connect with” its target audience of millennials and Gen-Z shoppers. Farylrobin supplied Target with products for the Wild Fable line, including the Infringing Product:

Vans' Old Skool Shoe



Defendants' Infringing Product



35. Upon information and belief, the Infringing Product is a calculated and intentional infringement of Vans' footwear products bearing the Vans Trademarks and Trade Dress and has been designed to confuse the purchasing public as to source by deliberately incorporating the distinctive elements of the Vans Trademarks and Trade Dress.

36. In addition to copying the Vans Trademarks and Trade Dress, Defendants also copy additional features of the Old Skool Shoe, which further shows their intent to copy Vans' products and trade on Vans' reputation, including the classic white-on-black color scheme and the overall shape and silhouette. Copying these features in addition to the Vans Trademarks and Trade Dress also further increases the likelihood that consumers will be confused and will improperly associate the

1 Infringing Product with Vans and its Trademarks and Trade Dress.

2 37. Defendants' further increase the likelihood that consumers will be
3 confused by promoting and selling the Infringing Product alongside goods bearing
4 a checkerboard pattern, which is a signature design element on many authentic
5 VANS products and which is strongly associated with Vans and the Old Skool
6 Shoe. For example, in the following promotional photograph for the Wild Fable
7 line, the model is holding a checkerboard bag next to the Infringing Product.



21 38. Upon information and belief, search results for the term "women's Vans
22 shoes" on the Target website include the Infringing Product.

23 39. Target features the Infringing Product prominently on its website and in
24 its marketing of the Wild Fable line, with many of the photographs of Wild Fable
25 apparel showing models wearing the Infringing Product. For example:



40. Upon information and belief, Target associates the Infringing Product with skateboarding to further associate itself and its products with Vans and trade on Vans' history and its reputation for authenticity in skateboarding and street culture. Target's YouTube Channel includes videos promoting the Wild Fable line, examples of which can be found at www.youtube.com/user/Target/. The videos have a skateboarding theme, and include models wearing the Infringing

1 Product. At least one model in the video is depicted wearing the Infringing
2 Product while on a skateboard. Indeed, particularly in the context of the
3 promotional video, consumers are likely to believe that the model is wearing
4 authentic Vans shoes.



16 41. Consumers readily associate the Infringing Product with Vans. For
17 example, Target's own customers refer to the Infringing Product as "fake Vans" on
18 the Target website in the Ratings and Reviews section. For example:

19 **My feet and my wallet are happy!**

20 (would recommend)

21 ★★★★ nanersammich—1 month ago

22 Cool fake vans at a fraction of the price without compromising quality! For cheap shoes, I was surprised that
I didn't even have to break them in for them to be comfortable. [see more](#)

23 Do you find this helpful?

24 yes (0) / no (0) / report

25 ★★★★ El Ramirez—2 months ago

26 verified purchaser

27 I love my fake Vans! I read some reviews that said to go a 1/2 a size down but for me that wasn't a good fit.
Getting my size was well, perfect!

28 Do you find this helpful?

yes (0) / no (0) / report

1 (emphasis added).

2 42. Furthermore, consumers will likely initially think that the Infringing
3 Product is an authentic Old Skool Shoe. For example, in a video available at
4 https://youtu.be/E0GVvaWhF_Q, a fashion blogger not only notes that the
5 Infringing Product looks like an authentic Vans product and is a “Vans ‘knock-
6 off[s],’” but also indicates that she was initially attracted to the shoes because they
7 looked like Vans (“I looked and I was like, oh hey babe, knockoffs, and then I was
8 like \$15, you’re coming home with me.”). Therefore, the Infringing Product is
9 also likely to cause initial interest confusion.

10 43. Defendant Target has a long and prominent history of collaborating with
11 independent fashion labels that have cachet with Target’s customers. For example,
12 within the past ten years Target has collaborated with a range of high-end and
13 popular labels including Missoni, Jason Wu, Toms, Lilly Pulitzer, and Hunter.
14 Because Target has established a reputation with consumers for developing
15 collaborations with popular brands that include shoes, accessories, and clothing,
16 consumers will likely make the mistaken assumption that the Infringing Product is
17 in fact the result of a collaboration between Target and Vans.

18 44. The Infringing Product is also likely to cause confusion under post-sale
19 conditions, as potential consumers observing Target customers wearing the
20 Infringing Product will likely mistakenly believe the Infringing Product is sold by
21 or associated with Vans. Indeed, as the Target promotional discussed in Paragraph
22 40 demonstrates, the Infringing Product is indistinguishable for authentic Vans’
23 Old Skool Shoes in typical post-sale conditions.

24 45. Defendants are well aware of the extraordinary fame and strength of the
25 Vans Trademarks and Trade Dress and the incalculable goodwill embodied therein,
26 and Defendants, upon information and belief, were familiar with the Vans
27 Trademarks and Trade Dress when Defendants created, imported, and began
28 advertising and selling the Infringing Product.

1 46. Upon information and belief, Defendants' infringement is intended to
2 trade on and misappropriate Vans' well established reputation and extensive
3 goodwill with Defendants' target audience of millennial and Gen-Z shoppers.

4 47. Upon information and belief, Defendants' copied the Vans Trademarks
5 and Trade Dress not only because of the Old Skool Shoe's extreme popularity
6 among Defendants' target consumers, but also to misappropriate Vans' iconic
7 reputation and cachet in pop-culture and street culture to lend unwarranted and
8 instant credibility to its Wild Fable line of apparel and accessories upon its launch.

9 48. Defendants knowingly, willfully, and intentionally adopted and used a
10 substantially indistinguishable and confusingly similar imitation of the Vans
11 Trademarks and Trade Dress.

12 49. Upon information and belief, Defendants intentionally designed and
13 manufactured the Infringing Product to mislead and deceive consumers into
14 believing it was manufactured, sold, authorized, or licensed by Vans.

15 50. Upon information and belief, the Infringing Product is made of cheaper
16 and inferior quality materials than genuine Vans products.

17 51. Because the Infringing Product is a confusingly similar imitation of
18 Vans' footwear products and deliberately makes use of and mimics the Vans
19 Trademarks and Trade Dress, and because consumers readily associate the Vans
20 Trademarks and Trade Dress with Vans, both prospective and current consumers
21 encountering the Infringing Product are likely to be confused as to its source,
22 including at point of sale or under pre- and post-sale circumstances, and will
23 believe that the Infringing Product is designed, licensed, or authorized by Vans.
24 This likelihood of confusion and damage to Vans' reputation as a result of the
25 Infringing Product's inferior quality and cheaper construction is another source of
26 damage.

27 52. Upon information and belief, Defendants intend to continue to design,
28 manufacture, advertise, promote, sell, or offer for sale the Infringing Product

1 unless otherwise restrained.

2

3 **FIRST CLAIM FOR RELIEF**

4 **(Federal Trade Dress Infringement)**

5 53. Vans repeats and incorporates by reference the allegations of each of the
6 preceding paragraphs.

7 54. Vans has used the Old Skool Trade Dress long prior to Defendants'
8 marketing, distribution, offer for sale and sale of the Infringing Product.

9 55. Defendants' use of confusingly similar imitations of the Old Skool Trade
10 Dress is likely to cause confusion, deception, and mistake by creating the false and
11 misleading impression that Defendants' good is manufactured or distributed by
12 Vans, or is associated or connected with Vans, or has the sponsorship,
13 endorsement, or approval of Vans.

14 56. Defendants have used marks confusingly similar to the Old Skool Trade
15 Dress in violation of 15 U.S.C. § 1125(a). Defendants' activities have caused and,
16 unless enjoined by this court, will continue to cause a likelihood of confusion and
17 deception among members of the trade and purchasing public and injury to Vans'
18 goodwill and reputation as symbolized by the Old Skool Trade Dress, for which
19 Vans has no adequate remedy at law.

20 57. Defendants' actions demonstrate an intentional, willful, and malicious
21 intent to trade on the goodwill associated with the Old Skool Trade Dress Trade
22 Dress to Vans' great and irreparable harm.

23 58. Defendants have caused and are likely to continue causing substantial
24 injury to the public and to Vans, and Vans is entitled to injunctive relief and to
25 recover Defendants' profits, actual damages, enhanced profits and damages, costs,
26 and reasonably attorneys' fees under 15 U.S.C. §§ 1116, and 1117.

SECOND CLAIM FOR RELIEF
(Federal Trademark Infringement)

59. Vans repeats and incorporates by reference the allegations of each of the preceding paragraphs.

60. Vans has used and registered the Side Stripe Trademark long prior to Defendants' marketing, distribution, offer for sale and sale of the Infringing Product.

61. Defendants' use of confusingly similar imitations of the Side Stripe Trademark is likely to cause confusion, deception, and mistake by creating the false and misleading impression that Defendants' Infringing Product is manufactured or distributed by Vans, or is associated or connected with Vans, or has the sponsorship, endorsement, or approval of Vans.

62. Defendants have used marks confusingly similar to the Side Stripe Trademark in violation of 15 U.S.C. §§ 1114 and 1125(a). Defendants' activities have caused and, unless enjoined by this court, will continue to cause a likelihood of confusion and deception among members of the trade and purchasing public and injury to Vans' goodwill and reputation as symbolized by the Side Stripe Trademark, for which Vans has no adequate remedy at law.

63. Defendants' actions demonstrate an intentional, willful, and malicious intent to trade on the goodwill associated with the Side Stripe Trademark to Vans' great and irreparable harm.

64. Defendants have caused and are likely to continue causing substantial injury to the public and to Vans, and Vans is entitled to injunctive relief and to recover Defendants' profits, actual damages, enhanced profits and damages, costs, and reasonable attorneys' fees under 15 U.S.C. §§ 1114, 1116, and 1117.

THIRD CLAIM FOR RELIEF
(Federal Unfair Competition)

65. Vans repeats and incorporates by reference the allegations of each of the preceding paragraphs.

66. Defendants' use of confusingly similar imitations of the Vans Trademarks and Trade Dress has caused and is likely to cause confusion, deception, and mistake by creating the false and misleading impression that Defendants' Infringing Product manufactured or distributed by Vans, or is affiliated, connected, or associated with Vans, or has the sponsorship, endorsement, or approval of Vans.

67. Defendants have made false representations, false descriptions, and false designations of its goods in violation of 15 U.S.C. § 1125(a). Defendants' activities have caused and, unless enjoined by this Court, will continue to cause a likelihood of confusion and deception of members of the trade and purchasing public and injury to Vans' goodwill and reputation as symbolized by the Vans Trademarks and Trade Dress, for which Vans has no adequate remedy at law.

68. Defendants' actions demonstrate an intentional, willful, and malicious intent to trade on the goodwill associated with the Vans Trademarks and Trade Dress to Vans' great and irreparable harm.

69. Defendants' conduct has caused, and is likely to continue causing, substantial injury to the public and to Vans. Vans is entitled to injunctive relief and to recover Defendants' profits, actual damages, enhanced profits and damages, costs, and reasonable attorneys' fees under 15 U.S.C. §§ 1125(a), 1116, and 1117.

FOURTH CLAIM FOR RELIEF

(California Unfair and Deceptive Trade Practices)

70. Vans repeats and incorporates by reference the allegations of each of the preceding paragraphs.

71. Defendants are intentionally and in bad faith passing off their Infringing Product as a product of Vans, causing a likelihood of confusion or misunderstanding as to the source, sponsorship, or approval of Defendants' Infringing Product, causing a likelihood of confusion as to Defendants' affiliation, connection, or association with Vans, and otherwise damaging the public.

72. Defendants' conduct constitutes unfair and deceptive acts or practices in the course of a business, trade, or commerce in violation of the unfair and deceptive trade practices statute of California Business and Professions Code §17200.

73. Defendants' deceptive trade practices have caused and are likely to cause substantial injury to the public and to Vans. Vans is therefore entitled to injunctive relief and to recover damages and, if appropriate, punitive damages, costs, and reasonable attorneys' fees.

FIFTH CLAIM FOR RELIEF

(Common Law Trademark Infringement and Unfair Competition)

74. Vans repeats and incorporates by reference the allegations of each of the preceding paragraphs.

75. Due to its over forty years of continuous use, Vans owns valid and enforceable common law rights in the Vans Trademarks and Trade Dress.

76. Defendants' acts constitute common law trademark infringement and unfair competition, and have created and will continue to create, unless restrained by this Court, a likelihood of confusion to the irreparable injury of Vans. Vans has no adequate remedy at law for this injury.

77. Upon information and belief, Defendants acted with full knowledge of Vans' use of, and common law rights in, the Vans Trademarks and Trade Dress and without regard to the likelihood of confusion of the public created by Defendants' activities.

78. Defendants' actions demonstrate an intentional, willful, and malicious intent to trade on the goodwill associated with the Vans Trademarks and Trade Dress to the great and irreparable injury of Vans.

79. As a result of Defendants' acts, Vans has been damaged in an amount not yet determined or ascertainable. At a minimum, however, Vans is entitled to injunctive relief, and to an accounting of Vans' profits, damages, and costs. Further, in light of the deliberately fraudulent and malicious use of confusingly similar imitations of Vans Trademarks and Trade Dress, and the need to deter Defendants from engaging in similar conduct in the future, Vans is entitled to punitive damages.

PRAYER FOR RELIEF

WHEREFORE, Vans prays that:

1. Defendants and all of their agents, officers, employees, representatives, successors, assigns, attorneys, and all other person acting for, with, by, through, or under authority from Defendants, or in concert or participation with Defendants, and each of them, be enjoined both preliminarily and permanently from:

- a. using the Vans Trademarks and Trade Dress or any copy, reproduction, colorable imitation, or simulation of the Vans Trademarks and Trade Dress on or in connection with Defendants' goods;
- b. using any trademark, name, logo, design, or source designation of any kind or in connection with Defendants' goods or services that is a copy, reproduction, colorable imitation, or simulation of, or confusingly similar to any of Vans' trademarks, trade dress, names, or logs, including, but not limited to, the Vans Trademarks and Trade Dress;
- c. using any trademark, name, logo, design, or source designation of any

kind on or in connection with Defendants' goods that is likely to cause confusion, mistake, deception, or public misunderstanding that such goods or services are produced or provided by Vans, or are sponsored or authorized by Vans, or are in any way connected or related to Vans;

- d. passing off, palming off, or assisting in passing off or palming off Defendants' Infringing Product as that of Vans, or otherwise continuing any and all acts of unfair competition as alleged in this Complaint; and
- e. manufacturing, distributing, importing, advertising, promoting, offering for sale, or selling the Infringing Product or other similar goods.

2. Defendants be ordered to cease offering for sale, marketing, promoting, and selling, to remove from their retail stores, and to recall all products under or bearing a confusingly similar imitation of the Vans Trademarks and Trade Dress, including, but not limited to, the Infringing Product, which is in Defendants' possession or has been shipped by Defendants or under their authority, to any customer, including, but not limited to, any wholesaler, distributor, retailer, consignor, or marketer, and also to deliver to each customer a copy of this Court's order as it relates to said injunctive relief against Defendants;

3. Defendants be ordered to deliver up for impoundment and for destruction all footwear, apparel, bags, boxes, labels, tags, signs, packages, receptacles, advertising, sample books, promotional materials, stationary, or other materials in the possession, custody or under the control of Defendants that are found to adopt or infringe any of Vans trademarks or trade dress, including, but not limited to, the Vans Trademarks and Trade Dress, or that otherwise unfairly compete with Vans and its products;

4. Defendants be compelled to account to Vans for any and all profits derived by Defendants from the sale or distribution of Infringing Product as

1 described in this Complaint;

2 5. Vans be awarded all damages caused by the acts forming the basis of this
3 Complaint;

4 6. Based on Defendants' knowing and intentional use of the Vans
5 Trademarks and Trade Dress and confusingly similar imitations of the Vans
6 Trademarks and Trade Dress, the damages awarded be trebled and the award of
7 Defendants' profits be enhanced as provided for by 15 U.S.C. § 1117(a) and (b).

8 7. Defendants be required to pay to Vans the costs and reasonable
9 attorneys' fees incurred by Vans in this action pursuant to 15 U.S.C. § 117(a) and
10 California Business and Professions Code §17200;

11 8. Vans be awarded prejudgment and post-judgment interest on all
12 monetary awards; and

13 9. Vans have such other and further relief as this Court may deem just.

14
15 DATED: December 20, 2018

VANS, INC. and VF OUTDOOR, LLC

16
17 *By their Attorneys*

18
19
20 By: /s/Greg Nylen

21 Greg Nylen

22 Kevin Abbott

23 LOBB & PLEWE, LLP

24 4160 Temescal Canyon Rd., Suite 202
Corona, CA 92883

25 James Donoian (*pro hac vice* forthcoming)
26 Aya Cieslak-Tochigi (*pro hac vice*
forthcoming)

27 McCarter & English, LLP
825 Eighth Avenue, 31st Floor
New York, NY 10019

1 Keith Toms (*pro hac vice* forthcoming)
2 Quincy Kayton (*pro hac vice* forthcoming)
3 McCarter & English, LLP
4 265 Franklin St.
5 Boston, MA 02140

6 Aaron Y. Silverstein
7 Saunders & Silverstein LLP
8 14 Cedar Street, Suite 224
9 Amesbury, MA 01913

1 **DEMAND FOR JURY TRIAL**
2

3 Pursuant to Federal Rule 38(b), Vans hereby demands a jury trial on all
4 issues so triable that are raised by this Complaint.
5

6 DATED: December 20, 2018

7 **VANS, INC. and VF OUTDOOR, LLC**

8 *By their Attorneys*

9

10 By: /s/ Greg Nylen

11 Greg Nylen

12 Kevin Abbott

13 LOBB & PLEWE, LLP

14 4160 Temescal Canyon Rd., Suite 202

15 Corona, CA 92883

16 James Donoian (*pro hac vice pending*)

17 Aya Cieslak-Tochigi (*pro hac vice*
18 forthcoming)

19 McCarter & English, LLP

20 825 Eighth Avenue, 31st Floor

21 New York, NY 10019

22 Keith Toms (*pro hac vice pending*)

23 Quincy Kayton (*pro hac vice pending*)

24 McCarter & English, LLP

25 265 Franklin St.

26 Boston, MA 02140

27 Aaron Y. Silverstein (*pro hac vice pending*)

28 Saunders & Silverstein LLP

29 14 Cedar Street, Suite 224

30 Amesbury, MA 01913

EXHIBIT A

Int. Cl.: 25

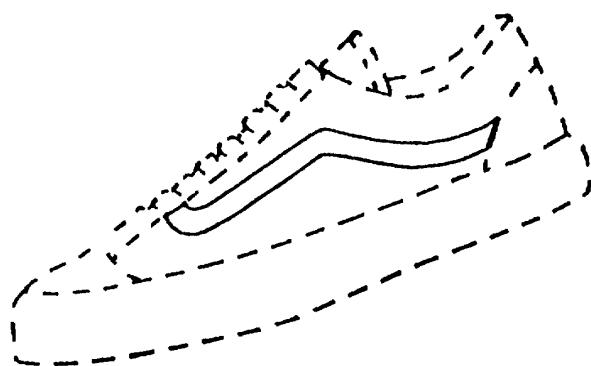
Prior U.S. Cls.: 22 and 39

Reg. No. 2,177,772

United States Patent and Trademark Office

Registered Aug. 4, 1998

TRADEMARK
PRINCIPAL REGISTER



VANS, INC. (DELAWARE CORPORATION)
2095 BATAVIA STREET
ORANGE, CA 926653101

FOR: FOOTWEAR, IN CLASS 25 (U.S. CLS. 22
AND 39).

FIRST USE 0-0-1971; IN COMMERCE
0-0-1971.

THE MATTER SHOWN BY THE DOTTED
LINES IS NOT PART OF THE MARK AND
SERVES ONLY TO SHOW THE POSITION OF
THE MARK.

SEC. 2(F).

SER. NO. 75-091,541, FILED 4-19-1996.

KIM SAITO, EXAMINING ATTORNEY

EXHIBIT B

Int. Cl.: 25

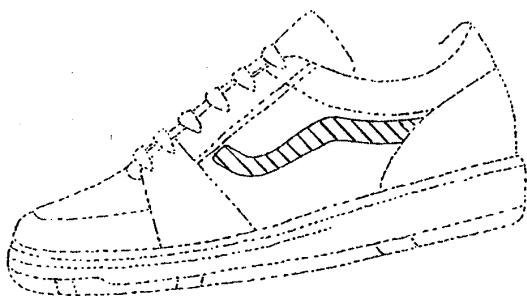
Prior U.S. Cls.: 22 and 39

Reg. No. 2,172,482

United States Patent and Trademark Office

Registered July 14, 1998

**TRADEMARK
PRINCIPAL REGISTER**



VANS, INC. (DELAWARE CORPORATION)
2095 BATAVIA
ORANGE, CA 92865

FOR: FOOTWEAR, IN CLASS 25 (U.S. CLS. 22
AND 39).

FIRST USE 0-0-1971; IN COMMERCE
0-0-1971.

THE LINING IS FOR SHADING PURPOSES
ONLY AND DOES NOT INDICATE COLOR.

THE MARK CONSISTS OF THE DESIGN ON
THE SIDE OF THE SHOE. THE MATTER
SHOWN BY THE DOTTED LINE IS NOT PART
OF THE MARK AND SERVES ONLY TO SHOW
THE POSITION OF THE MARK.

SEC. 2(F).

SER. NO. 75-229,184, FILED 1-22-1997.

KIM SAITO, EXAMINING ATTORNEY

EXHIBIT C

Int. Cl.: 25

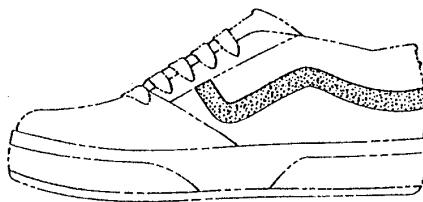
Prior U.S. Cls.: 22 and 39

Reg. No. 2,170,961

United States Patent and Trademark Office

Registered July 7, 1998

**TRADEMARK
PRINCIPAL REGISTER**



VANS, INC. (DELAWARE CORPORATION)
2095 BATAVIA
ORANGE, CA 92865

THE MATTER SHOWN BY THE DOTTED LINE IS NOT PART OF THE MARK AND SERVES ONLY TO SHOW THE POSITION OF THE MARK.

FOR: FOOTWEAR, IN CLASS 25 (U.S. CLS. 22 AND 39).

SEC. 2(F).

FIRST USE 0-0-1971; IN COMMERCE 0-0-1971.

SER. NO. 75-229,182, FILED 1-22-1997.

THE STIPPLING IS FOR SHADING PURPOSES ONLY AND DOES NOT INDICATE COLOR.

KIM SAITO, EXAMINING ATTORNEY

EXHIBIT D

United States of America

United States Patent and Trademark Office



Reg. No. 4,442,122

VANS, INC. (DELAWARE CORPORATION)
6550 KATELLA AVE
CYPRESS, CA 90630

Int. Cl.: 25

FOR: CLOTHING, NAMELY, T-SHIRTS, SHIRTS, SWEATSHIRTS, PANTS, SHORTS, DENIMS, SWEATER, JACKETS, BELTS, BOXERS, SOCKS, SCARVES, UNDERWEAR AND SWIMWEAR; HEADGEAR, NAMELY, HATS, CAPS AND BEANIES , IN CLASS 25 (U.S. CLS. 22 AND 39).

TRADEMARK

PRINCIPAL REGISTER

FIRST USE 0-0-1971; IN COMMERCE 0-0-1971.

OWNER OF U.S. REG. NOS. 2,170,961, 2,172,482, AND 3,906,529.

THE MARK CONSISTS OF A WAVE LINE.

SER. NO. 85-361,562, FILED 7-1-2011.

KATHRYN COWARD, EXAMINING ATTORNEY



Deborah S. Cohen

Commissioner for Trademarks of the
United States Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

Requirements in the First Ten Years*

What and When to File:

First Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See 15 U.S.C. §§1058, 1141k.* If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

Second Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.*
See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*

What and When to File:

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or
reminder of these filing requirements.**

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See 15 U.S.C. §§1058, 1141k.* However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See 15 U.S.C. §1141j.* For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.